



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,867	07/31/2001	A. Peter Powell	41698-1024	2424

7590 07/19/2004
Alex L. Yip
Kaye Scholer LLP
425 Park Avenue
New York, NY 10022

EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 07/19/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,867

Applicant(s)

POWELL ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>16</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1-3, 5-6, 8, 15-16, 25-27, 29-31, 35 and 38-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 5,504,805) in view of Yue et al. (US 5,937,050).

Regarding **claims 1 and 8**, Lee discloses an apparatus for facilitating communications between a caller and a called party (column 1, lines 8-10), the apparatus comprising:

storage (18 on FIG. 1) for storing a message (column 3, line 62 "record a message") for the called party (column 3, line 48 "the called party") provided by the caller (column 3, line 62 "the calling party"), and data concerning a telephone number (column 3, line 66 "a number") in association with the message for contacting the caller (column 3 line 44 to column 4, line 4) [The calling party attempts to leave a message for the called party and a number is recognized in the verbal message provide by the calling and is loaded into the memory];

a mechanism interface (26 on FIG. 1) for causing an establishment of a first connection to deliver the message therethrough to the called party in accordance with the preference (column 2, line 53 to column 3, line 4) [The controller allows the called party to retrieve messages through the telephone network interface inherently establishing a connection with the called party];

a device (28 on FIG. 1) for detecting a signal generated by the called party (column 5, line 10 "commanded the microprocessor to dial the number"), which indicates an initiation of a call to the caller (column 5, lines 2-13) [The microprocessor determines whether the command received from the called party is to dial the number]; and

a switch interface (10 on FIG. 1) responsive to the detected signal for retrieving from the storage the data concerning the telephone number stored in association with the message, a second connection to a communication device associated with the telephone number being established based on the retrieve data, the first connection being connected to the second connection (column 5, lines 13-20) [The microprocessor

Art Unit: 2645

retrieves and transfers the phone number to the dialer to dial the number through the telephone network interface inherently connecting the called party to the calling party].

Lee discloses prompting the caller to leave a message for the subscriber but fails to disclose an interface for prompting the caller to provide at least one preference concerning delivery of the message.

However, Yue teaches the message sender is prompting for options for delivering the message by the system and according to the caller selection marks the message for delivery (column 24, lines 34-58).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Lee using the voicemail system as taught by Yue.

This modification of the Lee's invention would speed the delivery of the messages so that the user would choose the specific destination of the voice message.

Regarding **claims 2 and 26**, Lee discloses the message is recorded by the caller (column 3, lines 44-67).

Regarding **claims 3 and 27**, Lee discloses a message identification is assigned to the message for association with the telephone number (column 4, lines 51-65).

Regarding **claims 5, 15, 29 and 38**, Lee discloses the telephone number is provided by the caller (column 3, lines 44-67).

Regarding **claims 6, 16, 30 and 39**, Lee discloses the signal includes a DTMF signal (column 2, lines 53-67).

Regarding **claims 12 and 35**, Lee discloses the call was unanswered due to a ring-no-answer condition (column 3, lines 44-67).

Regarding **claim 25**, Lee discloses a method for facilitating communications between a caller and a called party (column 1, lines 8-10), the method comprising:

storing a message for the called party provided by the caller, and data concerning a telephone number in association with the message for contacting the caller (column 3 line 44 to column 4, line 4) [The calling party attempts to leave a message for the called party and a number is recognized in the verbal message provide by the calling and is loaded into the memory];

causing an establishment of a first connection to deliver the message therethrough to the called party in accordance with the preference (column 2, line 53 to column 3, line 4) [The controller allows the called party to retrieve messages through the telephone network interface inherently establishing a connection with the called party];

detecting a signal generated by the called party, which indicates an initiation of a call to the caller (column 5, lines 2-13) [The microprocessor determines whether the command received from the called party is to dial the number];

in response to the detected signal retrieving from the storage the data concerning the telephone number stored in association with the message, causing an establishment of a second connection to the telephone number based on the retrieve data, and connecting the first connection to the second connection (column 5, lines 13-20) [The microprocessor retrieves and transfers the phone number to the dialer to dial the number through the telephone network interface inherently connecting the called party to the calling party].

Lee discloses prompting the caller to leave a message for the subscriber but fails to disclose prompting the caller to provide at least one preference concerning delivery of the message.

However, Yue teaches the message sender is prompting for options for delivering the message by the system and according to the caller selection marks the message for delivery (column 24, lines 34-58).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Lee using the voicemail system as taught by Yue.

This modification of the Lee's invention would speed the delivery of the messages so that the user would choose the specific destination of the voice message.

Regarding **claim 31**, Lee discloses a method for use in a messaging system (column 1, lines 8-10), comprising:

storing a message for a called party provided by a caller whose call to a called station associated with the called party was previously unanswered, and data

Art Unit: 2645

concerning a telephone number in association with the message for contacting the caller (column 3 line 44 to column 4, line 4) [The calling party attempts to leave a message for the called party and a number is recognized in the verbal message provide by the calling and is loaded into the memory];

establishing a first connection to the called station to deliver therethrough the message in accordance with the preference (column 2, line 53 to column 3, line 4) [The controller allows the called party to retrieve messages through the telephone network interface inherently establishing a connection with the called party];

detecting a predetermined signal from the called station (column 5, lines 2-13) [The microprocessor determines whether the command received from the called party is to dial the number];

in response to the detected predetermined signal, retrieving from the storage the data concerning the telephone number stored in association with the message, establishing a second connection to a calling station associated with the stored telephone number based on the retrieve data, and connecting the first connection to the second connection (column 5, lines 13-20) [The microprocessor retrieves and transfers the phone number to the dialer to dial the number through the telephone network interface inherently connecting the called party to the calling party].

Lee discloses prompting the caller to leave a message for the subscriber but fails to disclose eliciting from the caller at least one preference concerning delivery of the message.

However, Yue teaches the message sender is prompting for options for delivering the message by the system and according to the caller selection marks the message for delivery (column 24, lines 34-58).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Lee using the voicemail system as taught by Yue.

This modification of the Lee's invention would speed the delivery of the messages so that the user would choose the specific destination of the voice message.

4. **Claims 4, 14, 28 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view Yue and in further view of Hammond (US 5,155,761).

Regarding **claims 4, 14, 28 and 37**, Lee and Yue as applied to **claims 1, 8, 25 and 31** differs from **claims 4, 14, 28 and 37**, in that it fails to disclose an automatic number identifier.

However, Hammond teaches the telephone number is derived from an automatic number identifier (column 4, lines 51-56).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the automatic number identifier of Hammond in the invention of Lee.

The modification of the invention would offer the capability of an automatic number identifier of an automatic callback for certain incoming calls.

Art Unit: 2645

5. **Claims 7, 9-10, 13, 32-33 and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Yue and in further view of Corlett et al. (US 5,832,060).

Regarding **claims 7**, Lee and Yue as applied to **claim 1**, differs from **claim 7**, in that it fails to disclose a voice response unit.

However, Corlett teaches a voice response unit (18 on FIG. 1).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the voice response unit of Corlett in the invention of Lee.

The modification of the invention would offer the capability of a voice response unit such as the system would facilitate connection between calling party and called party.

Regarding **claims 9 and 32**, Corlett teaches the preference includes a time range within which the message is delivered (column 10, lines 30-45).

Regarding **claims 10 and 33**, Corlett teaches the preference includes a number of attempts to deliver the message and the number of attempts is not greater than a predetermined maximum limit (column 10, lines 30-45).

Regarding **claims 13 and 36**, Corlett teaches wherein the call was unanswered due to a communication problem (column 6, lines 44-51).

6. **Claims 11 and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Yue and in further view of Gray et al. (US 5,625,682).

Regarding **claims 11 and 34**, Lee and Yue as applied to **claims 8 and 31**, differs from **claims 11 and 34**, in that it fails to disclose the call was unanswered due to a busy condition.

However, Gray teaches the call was unanswered due to a busy condition (column 3, lines 48-58).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the busy condition of Gray in the invention of Lee.

The modification of the invention would offer the capability of a busy condition such as the system would facilitate connection between calling party and called party.

7. **Claims 17-18 and 40-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray in view of Yue.

Regarding **claims 17 and 40**, Gray discloses a communications system accessible by a customer for obtaining information about a desired party (column 1, lines 5-8), the system comprising:

a server (30 on FIG. 2) for providing a destination telephone number for contacting the desired party (column 3 lines 11-19) [The trunk driver communicates to

the application to enable a message generation which is sent to the calling subscriber, who is inherently provided a destination number to the system];

a mechanism for causing an establishment of a first connection to a destination station (column 10, line 31 "a first call") associated with the destination telephone number (column 3, lines 20-30) [The calling subscriber using the telephone keypad to send a ticket number to establish a connection between the caller and the agent];

a processor (3 on FIG. 1) for monitoring signals on the first connection, the customer being prompted to provide a message (column 3, line 49 "a message") when a signal (column 3, line 48 "agents are busy") from the first connection indicating that the destination station is not answering is detected (column 3, lines 48-58) [The driver sends a message to the caller inviting the caller to leave a message];

storage (5 on FIG. 1) for storing the message provided by the customer and data concerning a calling telephone number (column 3, line 59 "the number") in association with the message for contacting the customer, a second connection to the destination station being established to deliver the message therethrough (column 3 line 59 to column 4, line 20) [The callback message is stored provided to a voicemail DSP driver for processing by the DSP, a connection is made to the agent when the agent is free];

a device (28 on FIG. 2) for detecting a predetermined signal (column 4, lines 14-20) [The line driver determines that the agent is free and causes the caller to be connected with the agent]; and

a switch interface (20 on FIG. 2) responsive to the detected predetermined signal for retrieving from the storage the data concerning the telephone number stored in

association with the message, a third connection to a calling station (column 5, line 26 “automatically dial the caller”) associated with the calling telephone number being established based on the retrieve data, the second connection being connected to the third connection (column 5, lines 18-28) [The application access the callback number left by the caller and connects the agent and the caller in a voice connection].

Gray discloses prompting the caller to leave a message for the subscriber but fails to disclose an interface for eliciting from the customer at least one preference concerning delivery of the message.

However, Yue teaches the message sender is prompting for options for delivering the message by the system and according to the caller selection marks the message for delivery (column 24, lines 34-58).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Gray using the voicemail system as taught by Yue.

This modification of the Gray's invention would speed the delivery of the messages so that the user would choose the specific destination of the voice message.

Regarding **claims 18 and 41**, Gray discloses the call was unanswered due to a busy condition (column 3, lines 48-58).

8. **Claims 19, 23-24, 42 and 46-47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray in view of Yue and in further view of Lee.

Regarding **claims 19 and 42**, Gray and Yue as applied to **claims 17 and 40**, differs from **claims 19 and 42**, in that it fails to disclose the call was unanswered due to a ring-no-answer condition.

However, Lee teaches the call was unanswered due to a ring-no-answer condition (column 3, lines 44-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Gray using the ring-no-answer as taught by Lee.

This modification of the Gray's invention would speed the delivery of the messages so that the user would choose the specific destination of the voice message.

Regarding **claims 23 and 46**, Lee teaches the telephone number is provided by the customer (column 3, lines 44-67).

Regarding **claims 24 and 47**, Lee teaches wherein the signal includes a DTMF signal (column 2, lines 53-67).

9. **Claims 20 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray in view of Yue and in further view of Corlett.

Regarding **claims 20 and 43**, Gray and Yue as applied to **claims 17 and 40**, differs from **claims 20 and 43**, in that it fails to disclose the call was unanswered due to a communication problem.

However, Corlett teaches the call was unanswered due to a communication problem (column 6, lines 44-51).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Gray using the communication problem as taught by Corlett.

This modification of the Gray's invention would speed the delivery of the messages so that the user would choose the specific destination of the voice message.

10. **Claims 21-22 and 44-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray in view of Yue and in further view of Hammond.

Regarding **claims 22 and 45**, Gray and Yue as applied to **claims 17 and 40**, differs from **claims 20 and 43**, in that it fails to disclose the telephone number is derived from an automatic number identifier.

However, Hammond teaches the telephone number is derived from an automatic number identifier (column 4, lines 51-56).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the automatic number identifier of Hammond in the invention of Gray.

The modification of the invention would offer the capability of an automatic number identifier of an automatic callback for certain incoming calls.

Regarding **claims 21 and 44**, Hammond teaches an operator assisting the customer to obtain the information (column 5, lines 25-40).

Response to Arguments

11. Applicant's arguments with respect to **claims 1-47** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.
July 11, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a long horizontal stroke extending to the right.